(1)

No. 04-

IN THE

Supreme Court of the United States

SHIGERU TAMAI,

Petitioner,

v.

CHRISTOPHER J. STEVENS,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

(1) Section 363 of the Patent Statute provides that "an ***international*** application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office" except as otherwise provided in section 102(e) of this title. In other words, an ***international*** application filed under the Patent Cooperation Treaty shall be treated as a national application. Does a Patent Office Rule requiring an applicant to file a motion claiming benefit of the filing date of an ***earlier*** application apply when the application involved in the interference is the ***international*** application, not an ***earlier*** application?

PARTIES

The parties to this proceeding are set forth in the caption.

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Petitioner Shigeru Tamai respectfully prays that this Court grant a writ of certiorari to review the judgment and opinion of the United States Court of Appeals for the Federal Circuit entered on May 4, 2004. Petitioner Tamai's request for Rehearing En Banc was rejected on June 10, 2004.

OPINIONS BELOW

The May 4, 2004 opinion of the Court of Appeals for the Federal Circuit, which is reported at 366 F.3d 1325, is set out at p. A1 of the Appendix to this petition. The March 13, 2003 final decision of the Board of Patent Appeals and Interferences is set out at p. B1. The denial of Stevens' request for reconsideration of the Board of Patent Appeals and Interferences is set out at p. C1.

JURISDICTION

The decision of the Court of Appeals for the Federal Circuit was entered on May 4, 2004. Petitioner Tamai's request for Rehearing En Banc was rejected on June 10, 2004. The jurisdiction of this Court is invoked pursuant to 28 U.S.C. §1254.

STATUTES AND REGULATION INVOLVED

(1) 35 U.S.C. §363. International application designating the United States: Effect

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent

regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title.

(2) 35 U.S.C. §371 (c). National stage: Commencement

(c) The applicant shall file in the Patent and Trademark Office--
(1) the national fee provided in section 41(a) of this title;
(2) a copy of the international application, unless not required under subsection (a) of this section or already communicated by the International Bureau, and a translation into the English language of the international application, if it was filed in another language;
(3) amendments, if any, to the claims in the international application, made under article 19 of the treaty, unless such amendments have been communicated to the Patent and Trademark Office by the International Bureau, and a translation into the English language if such amendments were made in another language;
(4) an oath or declaration of the inventor (or other person authorized under chapter 11 of this title) complying with the requirements of section 115 of this title and with regulations prescribed for oaths or declarations of applicants;
(5) a translation into the English language of any annexes to the international preliminary examination report, if such annexes were made in another language.

(3) 37 C.F.R. §1.633. Preliminary motions.

A party may file the following preliminary motions:
...

(f) A motion to be accorded the benefit of the filing date of an earlier filed application

(4) 37 C.F.R. §1.637. Content of motions.

(f) A preliminary motion for benefit under § 1.633(f) shall:

(1) Identify the earlier application.
(2) . . . When the earlier application is an application filed in a foreign country, certify that a copy of the application has been served on all opponents. If the earlier filed application is not in English, the requirements of § 1.647 must also be met.
(3) Show that the earlier application constitutes a constructive reduction to practice of each count.

STATEMENT OF THE CASE

This case does not involve a dispute of fact or interpretation of statute or rule; it involves the United States' abrogation of its treaty obligation under 35 U.S.C. §363 to treat patent applications filed under Patent Cooperation Treaty (PCT) as national applications originally filed in the United States.
Christopher J. Stevens ("Stevens") and Shigeru Tamai ("Tamai") were parties to Interference No. 103,662, declared May 9, 1997. Stevens' involved U.S. Patent No. 5,393,368 ("the '368 patent") was filed February 7, 1994, and issued February 28, 1995. Tamai's involved Application No. 08/196,839 ("the '839 application") was filed February 15, 1994. The '839 application is a continuation-in-part of U.S. Patent Application No. 08/030,183 ("the '183 application"), which was filed March 29, 1993. The notice declaring the interference accorded the '839 application the benefit of the filing date of the '183 application. On the basis of the March 29, 1993 filing date, Tamai was accorded senior party status. The '183 application was the national stage filing of a PCT application, PCT/JP2/00947 ("the PCT application"), filed on July 24. 1992.

The Board of Patent Appeals and Interferences ruled in favor Tamai, both in its final decision and in its denial of Stevens' request for reconsideration. In essence the Board of Patent Appeals and Interferences awarded the interference to Tamai because its filing date of March 29, 1993, predated Stevens' U.S. filing date of February 7, 1994. The Court of Appeals reversed the Board of Patent Appeals and Interferences, because Tamai had allegedly failed to comply with the Patent Office Rules for claiming benefit of an earlier filed application. The Court of Appeals reached this conclusion even though Tamai's March 29, 1993 filing date was for the very same application involved in the interference.

REASONS FOR GRANTING THE WRIT

The fatal, and out-come determinative, error in the Appeals Court's opinion is its treatment of Tamai's PCT '947 application and its involved '183 application as parent and child applications, for which benefit of the parent must be requested. They are, in fact, not parent and child; they are the same application – Tamai's involved '183 application was merely the entry into the national stage of Tamai's PCT '947 application (filed on July 24, 1992). The Panel's error is in violation of 35 U.S.C. §363 which provides that

> "[a]n international application designating the United States ***shall have the effect, from its international filing date under article 11 of the treaty, of a national application*** for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title." (Emphasis added). Tamai is entitled his July 24, 1992 PCT filing date, without any recourse to 35 U.S.C. §§119, 120

or 365 or to 37 C.F.R. §§1.633, 1.637 or 1.647.

The error is outcome determinative because, although Stevens' earliest possible foreign application date (February 1, 1993) ***precedes*** the date of Tamai's involved '183 application (March 29, 1993), ***it is later than*** Tamai's PCT '947 application (July 24, 1992).

Section 372(b)(3) of the Patent Statute ("the Director may require a verification of the translation of the international application or any document pertaining to the application if the application or other document was filed in a language other than English"), touted by the panel, merely authorizes the Patent Office to require a verification of the PCT application. Section 372(b)(3) does not, nor do any of the statutory or regulatory provisions cited in the panel decision, actually require such a verification. This was the implicit conclusion of the Patent Office when it awarded judgment to Tamai based upon its earlier Japanese '371 application.

At page 2 of the Court of Appeals' decision, the filing date of the '183 application is incorrectly stated to be March 29, 1993. This statement is contrary to 35 U.S.C. §363.

At pages 8, 11 and 12 of the decision, 35 U.S.C. §§ 119, 120, 121 and 365 are cited as statutory authority. However, these sections do not apply to the PCT '947 application.

At page 5 of Stevens' brief to the panel, Stevens brought the issue of proper statutory authority into play by incorrectly stating:

> Though not expressly stated in the motion, Tamai's claim of priority benefit was premised

on 35 U.S.C. § 120.

However, 35 U.S.C. § 120 does not apply to the PCT '947 application. Tamai could not claim priority benefit to the PCT '947 application under 35 U.S.C. § 363. MPEP §1893.03(c).

At page 12 of the decision, the Court of Appeals cites 35 U.S.C. § 372(b)(3), stating:

> And, while overlooked by Tamai, 35 U.S.C. § 372(b)(3) permits the Director to "require a verification of the translation of the international application or any other document pertaining to the application if the application or other document was filed in a language other than English."

Tamai has not overlooked this provision. 35 U.S.C. § 372(b)(3) gives the Director (Commissioner of the USPTO) the statutory authority to promulgate a Rule for requiring a verification of the translation of the international application, as a condition for entering the national stage. That Rule is 37 C.F.R. § 1.495(f). Tamai complied with this Rule and was granted entry into the national stage.

The Board had no authority to designate the national stage entry date as the filing date of Tamai's '183 application and to require any further verification of the translation.

Throughout the Court of Appeals decision, reference is made to 37 C.F.R. §§1.633, 1.637 and 1.647. These provisions do not apply to the PCT '947 application.

Sections 1.633 and 1.637 pertain to an "earlier

application" or an "earlier filed application."

The PCT '947 application is not an "earlier application" or an "earlier filed application". 35 U.S.C. §363. MPEP §§1893.03(b) & (c). The filing date of the '183 application is the July 24, 1992 filing date of the PCT '947 application. 35 U.S.C. § 363.

At page 12 of the Court of Appeals decision, reference is made to "applicant's transmittal letter" filed with Tamai's request for national stage entry. However, this request also included the Declaration of Tamai in addition to the transmittal letter. The transmittal letter is the signed statement of attorney Albert Tockman.

This Declaration of Tamai is the Declaration for U.S. Patent Application, executed by Shigeru Tamai on March 10, 1993 (hereinafter "the Tamai Declaration"). In view of the "I hereby declare . . ." statement at the bottom of the Declaration, this Tamai Declaration qualifies as a Declaration under 37 C.F.R. §1.68. Pursuant to 37 C.F.R. § 1.601(b), a Declaration under 37 C.F.R. §1.68 qualifies as an "affidavit" for interference purposes.

The Tamai Declaration attests that the specification of the invention is attached thereto and that this specification was filed on July 24, 1992, as the PCT '947 application. The specification attached to the Tamai Declaration is the specification of the '183 application. Therefore, the Tamai Declaration is an "affidavit" filed with the PCT '947 application and its English translation attesting to the fact that the translation accurately discloses the same subject matter as the PCT '947 application.

It is not asserted herein that the inventor, Tamai, is fluent in both English and Japanese. However, the interference rules specify that an affidavit may be based on information and belief. See 37 C.F.R §1.601(b) and 1.68. Such an affidavit is not necessarily optimal for interference purposes. For example, such an "information and belief" affidavit may be negated with an appropriate counter affidavit based on direct knowledge. However, the Tamai Declaration satisfies the basic requirement of an affidavit under the interference rules, including 37 C.F.R. 1.647.

Further at page 3 of its decision, the Court of Appeals stated: "Tamai also submitted an affidavit attesting that the disclosures of the two foreign language applications [the PCT '947 application and the Japanese '371 application] were substantially the same." Having attested that the English translation of the Japanese '371 application is an accurate translation and since both Japanese disclosures are substantially the same, it follows that the attested English translation is also an accurate translation of the PCT '947 application. *See Peska v. Satomura*, 602 F.2d 969, 972-973 (CCPA 1979), where "a side-by-side comparison shows that Peska's Czech disclosure is practically identical to the disclosure of his U.S. patent," thus entitling Peska, without more, to the benefit of the Czech disclosure.

As a point of clarification of the record, counsel for Tamai was asked at oral hearing before the panel to respond, yes or no, to the question of whether Tamai submitted with his motion for benefit a copy of the translation of the PCT application. The answer was, "Yes," because the translation submitted with the motion was made from the earlier Japanese '371 application, but it is averred in the motion that the PCT '947 application is substantially the same as the Japanese '371

application. Furthermore, the Declaration of Kinashi, who is fluent in both Japanese and English, attests that the translation submitted with Tamai's motion is a full and faithful translation of both the Japanese '371 application and the PCT '947 application.

The Declaration of Kinashi is cited on pages 16 and 17 of Tamai's Brief and is the affidavit referred to by the Court of Appeals in the above quoted passage at page 3 of the decision. Thus, the record included two translations of the PCT '947 application and two affidavits attesting to its accuracy. The two translations are (1) the translation submitted with the motion, which effectively translates **both** the Japanese '371 application and the PCT '947 application, and (2) the '183 application, which was submitted with the request to enter the national stage and, according to the national stage entry requirements, must be the translation of the PCT '947 application. The two affidavits are (1) the Declaration of Tamai, discussed above, which attested that the '183 application is the translation of the PCT '947 application and was submitted with the request to enter the national stage, and (2) the Declaration of Kinashi, which was submitted with the Tamai's reply to Stevens opposition to Tamai's motion.

Although the Kinashi declaration was not submitted with Tamai's motion, it was entered into the record. In Stevens opposition, Stevens did not object to Tamai's motion for failure to provide an affidavit. Had Stevens so objected, Tamai could have at least attempted to supply such an affidavit via 35 U.S.C. § 26 or some other remedial measure. *See Wingrove v. Langen*, 230 U.S.P.Q. 353 (BPAI 1985), where an interference party, who failed to submit a proper sworn statement attesting to the accuracy of a translation with a motion, was permitted to

submit such a sworn statement after the motion, pursuant to 35 U.S.C. § 26.

The Board of Patent Appeals and Interferences held that Figure 1 includes the elements of the count. This drawing is included in the PCT '947 application. A drawing may provide support for a claim. *Breen v. Cobb*, 487 F.2d 558, 559 (CCPA 1973), citing *In re Reynolds*, 443 F.2d 384 (CCPA 1971).

At page 8 of the decision, the Court of Appeals stated: (emphasis supplied herein)

> In the matter at hand, the Board held that because Tamai did not file with his motion for benefit an English language translation of the PCT '947 application **and an affidavit attesting to the accuracy of the translation**, Tamai had not proven that he was entitled to be accorded the filing date of the '947 application.

The Board did not hold that, because Tamai did not file with his motion **an affidavit** attesting to the accuracy of the translation, Tamai had not proven that he was entitled to be accorded the filing date of the PCT '947 application.

In opposing Tamai's motion, Stevens made no reference to **an affidavit** attesting to the accuracy of the translation. The first time such **an affidavit** was mentioned on the record was in Stevens Opposition to Tamai's Request for Reconsideration after the Board's decision. The first time Tamai had an opportunity to respond to Stevens new affidavit argument was Tamai's Brief to the Federal Circuit. Therefore, any alleged requirement of Tamai to file **an affidavit** attesting to the

accuracy of a translation was not timely raised and effectively waived by Stevens and the Board.

As noted on page 3 of the Court of Appeals decision, the opposition of Stevens to Tamai's benefit motion merely argued that a copy of the PCT '947 application and its translation were **not served** with the motion. The Board recognized that the PCT '947 application was part of the record of the '183 application. Therefore, the Board concluded that Stevens was not prejudiced by **not being served** an additional copy of the PCT '947 application.

However, the translation of the PCT '947 application was also part of the record of the '183 application. The specification of the '183 application is the translation of the PCT '947 application. Therefore, Stevens was also not prejudiced by not being served, at the time of the motion, an additional copy of the translation of the PCT '947 application.

The United States Patent and Trademark Office (USPTO) and the Federal Circuit did not comply with 35 U.S.C. §363 by treating the national stage entry date (March 29, 1993) as the filing date of Tamai's U.S. Application Serial No. 08/030,183, filed July 24, 1992.

As a mater of law, the filing date of Tamai's U.S. Application Serial No. 08/030,183 cannot be the date of national stage entry (March 29, 1993). 35 U.S.C. §363 mandates that this filing date can only be the filing date of the international application (July 24, 1992).

The question presented in this Petition is precedent-setting and of exceptional importance.

Counsel is unaware of any decisions, which would permit the USPTO to misconstrue the filing date of Tamai's application in the manner of the present interference.

The question presented is of exceptional importance for obvious reasons. Applicants are entitled to rely on the priority rights accorded by 35 U.S.C. §363. The United States is obligated under the Patent Cooperation Treaty to provide reciprocal rights to those accorded to international applicants in other countries.

CONCLUSION AND RELIEF REQUESTED

The decision of the Court of Appeals of May 4, 2004 should be vacated. The interference should be remanded with instructions to the Board to re-declare the interference, while designating July 24, 1992, as the filing date of Tamai's '183 application, by virtue of PCT/JP92/00947.

Stevens, on remand, could challenge whether Tamai satisfied the requirements for entering the national stage. However, the only potential issue remaining in the

interference would appear to be whether the '183 application is, in fact, an accurate translation of the PCT '947 application.

This Petition and the relief requested herein should be granted.

Respectfully submitted,

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